

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES R. OCHEL TREE
and BRET A. TRIMMER

Appeal No. 1996-3802
Application 08/296,790

ON BRIEF

Before KIMLIN, WARREN and OWENS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 3 through 5 and 7 through 10, and refusing to allow claim 2 as amended subsequent to the final rejection, which are all of the claims in the application. Claim 9 is illustrative of the claims on appeal:

9. An improved white food casing comprising regenerated cellulose containing titanium dioxide pigment in a weight ratio of less than 0.5 to regenerated cellulose in the casing and less than 15 grams per square meter of casing and containing a water insoluble violet pigment in an amount of less than 0.1 percent of the titanium dioxide in the casing and from about 0.3 to about 1.2 milligrams per square meter of casing, the quantity of combined titanium dioxide and water insoluble violet pigment being sufficient to impart an optical density of at least about 0.6, said titanium dioxide pigment and violet pigment being uniformly dispersed in the regenerated cellulose without agglomeration.

The appealed claims as represented by claim 9 are drawn to a white food casing comprising the specified amounts of titanium dioxide and a water insoluble violet pigment in regenerated cellulose which is sufficient to impart an optical density of at least about 0.6. According to appellants, the combination of the titanium dioxide and a water insoluble violet pigment in the specified amounts provides a food casing that “is nearly pure white in color” and “usually has an optical density at least as high as a similar food casing containing fifteen percent more titanium dioxide pigment and no violet pigment” (specification, page 5).

The reference relied on by the examiner is:

Balser et al. (Balser)

4,336,828

JUN. 29, 1982

The examiner has rejected all of the appealed claims under 35 U.S.C. § 103 as being unpatentable over Balser (answer, pages 3-4). We reverse.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the examiner’s answer and to appellants’ principal and reply briefs for a complete exposition thereof.

Opinion

We have carefully reviewed the record on this appeal and based thereon find that we cannot agree with the examiner that the claimed food casing encompassed by appealed claim 9 would have been *prima facie* obvious over Balser to one of ordinary skill in this art at the time the claimed invention was made.

The dispositive issue in this appeal is whether one of ordinary skill in this art following the teachings of Balser would have arrived at a food casing containing the specified amounts of a titanium dioxide pigment and a water insoluble violet pigment sufficient to impart an optical density of at least about 0.6. The examiner points out, in this respect, that Balser discloses that in addition to the titanium dioxide containing “metallic pearlescent (white) luster pigment . . . [c]oloring substances may be used to increase the contrast with the metallic pearlescent flake pigment and it is disclosed that a wide variety of pigments and coloring agents may be used” such “that it is within the ordinary skill in the art to be able to mix and match [pigments and coloring agents] to achieve a desired color,” citing col. 4, lines 31-50, and col. 11, lines 32-55 (answer, pages 3-4; see particularly Balser, col. 4, lines 31-39). The examiner further finds that Balser discloses that the food casings thereof have a “light-shielding function” (*id.*, page

4; see Balser, col. 6, lines 65-68). Based on these teachings of the reference, the examiner finds that “the goal and direction of Balser is to provide a white sausage casing . . . that is opaque” and the reference teaches “substituting the normally used titanium dioxide white pigment . . . with other pigments and dyes to achieve a desired effect” which “is what applicant has done [sic]” (*id.*, page 5). Thus, the examiner apparently concludes, without stating in so many words, that one of ordinary skill in this art would have selected a violet pigment and added the same in certain amounts, while adjusting the amount of the titanium dioxide pigment, to the white casings of Balser to achieve any desired result.

Appellants submit that the claimed food casing has “increased **opacity** while requiring less titanium dioxide to do so” and still be “white,” and that Balser neither suggests “adding a [small amount of] violet pigment” nor “the unobvious increase in opacity if such addition was made” (principal brief, page 4). In other words, it is appellants’ position that the “present invention does not concern ‘mix and match’ colors . . . [but] only ‘white’ having increased or at least constant opacity with a reduction in TiO₂ opacifier” (*id.*). The examiner responds to appellants’ arguments by finding that “adding a violet pigment would necessarily indicate that one would not need as much TiO₂ [sic] pigment to keep the casing either opaque or white “ and that “such information may be gleaned by . . . the routine practitioner without undue experimentation” (answer, pages 5-6). Appellants reply that there is no basis for the examiner’s “conclusion that adding violet pigment would keep the casing white” (reply brief, page 2).

On this record, we must agree with appellants’ position. We do agree with the examiner that Balser would have taught one of ordinary skill in this art to use known pigments that “are compatible with the liquid, aqueous alkaline reacting impregnating agent” to impart “dark shades in order to increase contrast with the metallic pearlescent flake pigment” to casings, that can have utility as, *inter alia*, food casings (e.g., col. 4, lines 31-39, col. 6, lines 48-59, and Examples 17, 19, 20 and 21). However, we find that the examiner has not provided in the record a scientific explanation or evidence which would demonstrate why one of ordinary skill in this art would have reasonably been led by these teaching to use “a water insoluble violet pigment” suitable for use in a “white food casing” in the casings of Balser in the amount specified in claim 9 and to adjust the amount of titanium dioxide pigment as specified in claim 9, which is less than the amount stated in Balser, with the reasonable expectation of obtaining the

claimed “white food casing” encompassed by the appealed claims. In the absence of such scientific explanation or evidence, Balser, at best, would have suggested to one of ordinary skill in this art “to try” any pigment imparting a “dark shade” that is suitable for any casing in amounts that would increase the contrast with the titanium dioxide pigment to provide the desired “pearlescence” which is “not the standard under § 103.” *In re O’Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (“In [other cases], what was ‘obvious to try’ was to explore a . . . general approach that seemed to be a promising field of experimentation where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. [Citations omitted.]”).

Accordingly, on this record, it is manifest that the only direction to appellants’ claimed invention as a whole is supplied by appellants’ own specification. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (“Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’s disclosure.”).

Having reached the conclusion that, on this record, the examiner has not established a *prima facie* case of obviousness, we need not consider the evidence in appellants’ specification.

The examiner’s decision is reversed.

Reversed

EDWARD C. KIMLIN
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)
)
)

Dunn & Simpson
P.O. Box 96
Newfane, NY 14108